

**PATENT**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of AARON LAMSTEIN	)	Group Art Unit: 3611
Application No. 10/801,258	)	Examiner: Joanne Silbermann
Filing Date: 3/15/2004	)	<b>APPEAL BRIEF</b>
For: PRODUCT DISPLAY SYSTEM	)	

05/19/2006 CNEBA1 00000034 10801258  
01 FC:2402 250.00 DP

Commissioner for Patents  
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**CERTIFICATE OF MAILING**

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By: Teri Nelmark  
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Sir:

Applicant hereby appeals the final rejection of claims 1-12, all of the claims contained in the present application. Applicant's Notice of Appeal was filed on May 10, 2006. As such, the present Brief on Appeal is timely filed under 37 CFR 41.37(c).

**REAL PARTY IN INTEREST**

The real party in interest involved in this application and appeal is Aaron M. Lamstein, inventor. Mr. Lamstein is affiliated with Worldwise Inc., having an equitable interest in the invention made the subject of the present application.

**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences known to applicant, applicant's legal representative or assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**STATUS OF CLAIMS**

All present claims 1-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, U.S. Patent No. 4,249,318 in view of Ali, U.S. Patent No. 6,042,151. There are no non-prior art rejections applied to any of the claims.

**STATUS OF AMENDMENTS**

Applicant has not sought to amend any of claims 1-12 after final rejection.

**SUMMARY OF CLAIMED SUBJECT MATTER**

There are two independent claims in the present application and appeal, namely, claims 1 and 12. These claims will be discussed separately.

**A. Independent Claim 1**

Claim 1 is directed to a system for displaying multiple packages for purchase by consumers. For example, multiple packages 20 (Fig. 2) are displayed on, for example, peg bar hooks in columns 21, 22, 23 and 24 and rows 25, 26, 27 and 28. The display shown in Fig. 2 is spaced apart from a segmented display, an example of which is shown in Fig. 1 as display 10. Segmented display 10 identifies characteristics of a single entity and codes each segment of the segmented display to differentiate each characteristic from other characteristics of the segmented display. For example, in dealing with products to be consumed by pet owners and, particularly those who own cats, segmented display 10 shows feline activities that have one thing in common, that is, each activity is engaged in by a healthy pet cat. All of the segments of the display 10 are related to one another in that, again, they all deal with cat activities. Spaced apart from segmented display 10 are multiple package 20 which each have at least one of the codes of segmented display 10 to enable a consumer to associate a package with a characteristic of the entity, namely, in this instance, a cat activity.

**B. Independent Claim 12**

Claim 12 differs from claim 1 in specifying that segmented display 10 is in the form of a pie chart such as the one specifically illustrated in Fig. 1. In each instance, be it the invention recited in claim 1 or that recited in claim 12, an important feature of the present invention is that the multiple packages be spaced apart from the segmented display so that a consumer would generally look at the display first, note the identifying characteristics associated with a specific code, such as a color, and

then go to the package displayed and pick out the product corresponding to the sought after characteristic based upon the code or color shown by the product packaging.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, U.S. Patent No. 4,249,318 in view of Ali, U.S. Patent No. 6,042,151. It is the position of the Examiner that Anderson teaches a system for displaying multiple packages comprising segmented pie chart 12 (Fig. 4) that identifies characteristics of a single entity (paint color) and color codes each segment of the segmented display to differentiate each characteristic (color) from other characteristics of the display and positions multiple packages spaced apart from the segmented display (Fig. 7). The Examiner admits that Anderson does not teach each package further exhibiting at least one of the codes, however, the Examiner has taken the position that this is well known in the art. Ali is relied upon for teaching a display for multiple packages wherein each package exhibits at least one code, 24 (Fig 1). The codes in Ali are numeric and alphabetic. The Examiner thus concludes that it would have been obvious to a person having ordinary skill in the art to utilize such a code on each package of Anderson so that the packages may be easily arranged on shelves.

In completing the Examiner's rejection of claims 1-12, it is noted that the Examiner has taken official notice of paint tubes that include a place on the label or tube showing what color is in the tube. The Examiner again concludes that it would have been obvious to include in such a place (usually a sticker) on the tubes of Anderson so that if the tubes are removed from the display they can be correctly replaced.

### **ARGUMENT**

In an Official Action dated November 22, 2005, claims 1-11 of the present application were rejected as being anticipated or rendered obvious by U.S. Patent No. 6,042,151 (Ali). In response, applicant amended the claims by amending claims 1-11 to change "proximate" to "spaced apart from" to emphasize the fact that the identifying segmented display differentiating characteristics of products is employed remotely from the product so identified. Although applicant has always been of the view that this

characteristic of the present invention was inherently recited in the claims and in the specification that supported them, reciting the “spaced apart from” language certainly differentiated Ali which simply taught a sandpaper rack with pieces of sandpaper arranged by their grit or abrasiveness.

U.S. Patent No. 4,249,318 was cited for the first time at final rejection, the Examiner taking the position that its citation was necessary in view of the change in language from “proximate” to “spaced apart from.” It is the position of applicant that Anderson does nothing further to enhance the teachings of Ali, that its combination with Ali represents a classic case of hindsight reconstruction of applicant’s invention and, in fact, Anderson teaches away from applicant’s invention, as does Ali.

The Examiner has characterized Anderson as teaching a system for displaying multiple packages comprising a segmented pie chart 12 (Fig. 4) that identifies characteristics of a single entity (paint color) and color codes each segment of the segmented display to differentiate each character’s color from other characteristics of the display and positions multiple packages spaced apart from the segmented display (Fig. 7.). The Examiner candidly admits that Anderson does not teach each package further exhibiting at least one of the codes but concludes, without any prior art, that this is well known. Ali is again relied upon for teaching a display for multiple packages where each package exhibits at least one code, 24 (Fig.2). The Examiner thus concludes that it would have been obvious to a person having ordinary skill in the art to utilize such a code on each package of Anderson so that the packages may be easily arranged on shelves. Finally, the Examiner has taken “Official Notice” that paint tubes include a place on a label or tube showing what color is in the tube. The Examiner concludes that it would have been obvious to include such labels on the tubes of Anderson so that if the tubes were removed from the display they can be correctly replaced.

At the outset, applicant notes that Anderson teaches nothing more than a color chart teaching one how primary colors and related colors can be combined in order to achieve an appropriate color for use by an artist. For example, in column 3, lines 38-49, Anderson notes the objects of the claimed invention of the ‘318 patent:

It is accordingly an object of the present invention to provide a system for producing a spectral range of tonally related source color groupings or palettes suitable for rendering color compositions influenced by a selected total factor.

It is a further object of the present invention to provide in the context of paintings and other similar works a pre-mixed basic set of coloring materials which may be grouped to produce palettes from which may be derived other colors so that all colors so produced will show the influence of the total factor without the need for toning by the artist.

It is respectfully asserted that providing a color chart so that an artist knows what tube of color to use and to mix with other tubes of color has little or no relevance when it comes to applicant's claimed invention for a system of displaying multiple packages for purchase by consumers which are sold in conjunction with a spaced apart segmented display that identifies characteristics of a single entity and codes each segment of the segmented display to differentiate each characteristic from other characteristics of the segmented display wherein each of the multiple packages further exhibit at least one of the codes to enable a consumer to associate a package with a characteristic of a single entity associated with the codes. To provide an artist with a color chart so that the artist can simply know what colors to match with other colors simply is not related to applicant's invention.

In addition to the above discussion, it does not appear to be realistically conceivable that one familiar with Anderson would combine his teachings with those of Ali for any purpose whatsoever. Without applicant's disclosure, could one reasonably conclude that a person skilled in the art would combine a color chart for paint with a display for sandpaper to somehow render obvious applicant's invention?

Further, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based upon a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. As such, applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to have modified a unitary sandpaper rack with a paint display

suggesting how users can combine the paints to derive a desired color. It is thus respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 54 USPQ 2d 1308, 136 (Fed.Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

“[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to duplicate the claimed invention.”

*In re Fitch*, 23 USPQ 2d 1780, 1784 (Fed.Cir. 1992). Further, under Section 103, “it is impermissible...to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly supports to one of ordinary skill in the art.” *In re Wesslaw*, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestions, outside of applicant’s disclosure, in the prior art to combine such references, as a reasonable expectation of success must be both found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 20 USPQ 2d 1436 (Fed Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Furthermore, it is respectfully asserted that Anderson, like Ali, teach away from applicant’s invention. Specifically, the products being offered by Anderson (paint tubes) are displayed together with a color chart and, thus, the “spaced apart from” limitation remains a deficiency in the combination of references relied upon by the Examiner. For example, reference is made to column 12, lines 5-51 that discusses various figures showing the dispensing of paint from tubes on racks. For example, Fig. 7 shows a lazy-Susan type device where the color chart or palette 12 is displayed on top surface 24. As to Fig. 8, palette 12 is placed upon base surface 44. As to the dispensing container of Fig.

9, “a lower surface portion 40 is provided which carries the artist’s color wheels associated with each palette grouping associated with each family of coloring materials.” As Anderson concludes, “any of these arrangements provides a very informative, convenient and expedient aide in preparing a palette of paint in any given total selection preparatory to rendering of a color work.” Column 13, lines 3-6.

In summary, if anything, Anderson confirms the teachings of Ali in providing a dispenser whereby characteristics of the items being dispensed are made a part of the dispenser itself.

In addition to the above, it is quite clear from applicant’s claims and supporting specification that the thrust of applicant’s invention is to provide a system for displaying multiple packages for purchase by consumers. It is respectfully asserted that Anderson teaches is nothing more than a group of paint tubes which an artist is likely to own or possess in a complete set using the associate color chart to tell the artist which colors to mix to get a certain tonal palette. By contrast, applicant intends to assist a consumer in purchasing multiple low cost items, such as pet supplies, with characteristics that function in the ongoing care and well-being of a pet. Although the claims are not limited to pet supplies per se, one could not escape the commercial thrust of applicant’s invention noting that claims 1-11 include the preamble, “a system of displaying multiple packages for purchase by consumers.” Further, applicant’s claims clearly call for a system that comprises “a segmented display that identifies characteristics of a single entity and codes each segment of said segmented display to differentiate each characteristic from other characteristics of said segmented display.” Anderson simply does not do this.

#### **CLAIM APPENDIX**

1. A system for displaying multiple packages for purchase by consumers, said system comprising a segmented display that identifies characteristics of a single entity and codes each segment of said segmented display to differentiate each characteristic from other characteristics of said segmented display and positioning said multiple packages spaced apart from said segmented display, each of said multiple packages further exhibiting at least one of said codes to enable a consumer to associate a package with a characteristic of said entity.
2. The system of claim 1 wherein said code is a color code.

3. The system of claim 1 wherein said code is a numeric code.
4. The system of claim 1 wherein said code is an alphabetic code.
5. The system of claim 1 wherein said segmented display is a pie chart display.
6. The system of claim 1 wherein said single entity is a domestic pet and said multiple packages comprised health or exercise related products for said domestic pet.
7. The system of claim 6 wherein said domestic pet comprises a member selected from the group consisting of dogs, cats and birds.
8. The system of claim 1 wherein said multiple packages are displayed in sub groups of more than one package per sub group, all packages within each sub group being related by displaying a common code.
9. The system of claim 8 wherein packages displayed within said sub groups are displayed in a predetermined ascending or descending order.
10. The system of claim 9 wherein said order is determined by the cost of each package.
11. The system of claim 9 wherein said order is determined by the efficacy or complexity of each item.
12. A system for displaying multiple packages for purchase by consumers, said system comprising a segmented pie chart display that identifies characteristics of a single entity and color codes each segment of said segmented pie chart display to differentiate each characteristic from other characteristics of said segmented pie chart display and positioning said multiple packages spaced apart from said segmented pie chart display, each of said multiple packages further exhibiting at least one color of said color codes to enable a consumer to associate a package with a characteristic of said entity.

**EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.

For the reasons advanced above, it is respectfully asserted that the final rejection of claims 1-12 is misplaced and it is thus respectfully requested that it be reversed

Respectfully submitted.



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Dated: May 15, 2006

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